

Appl. No. 10/811,160
Atty. Docket No. 959
Amdt. dated April 26, 2006
Reply to Office Action dated April 7, 2006
Customer No. 27752

REMARKS

The Examiner has required restriction as to Claims 2, 10, and 17 (Group I), Claims 3, 4, 11, 12, and 16 (Group II), Claims 6, 7, 13, 14, 18, and 19 (Group III), and Claims 8, 15, and 20 (Group IV) of the instant Application because the inventions are distinct. For purposes of compliance with the election request and to expedite prosecution, Applicants elect, with emphatic traverse, Group III, comprising Claims 6, 7, 13, 14, 18, and 19.

Applicants assert that the Examiner's restriction requirement is improper in light of M.P.E.P. §§802.01, 803, and 806. "There are two criteria for a proper requirement for a restriction between patentable distinct inventions: 1) Inventions must be independent ... or distinct as claimed; and 2) There must be a serious burden on the Examiner if a restriction is not required...." *See* M.P.E.P. §806.

M.P.E.P. §802.01 defines "independent" as "having no disclosed relationship between the two or more subjects disclosed; that is, they are unconnected in design, operation, or effect...." Applicants respectfully submit that there is a disclosed relationship among the claims of Groups I-IV. Namely, each limitation utilizes the same novel and unobvious transport element, cutter, axial-traversing element, radial-transversing element, and controller. Thus, the broad apparatus and the combinations and sub-combinations thereof should not be restricted from the instant Application, as the Examiner so requires. Thus, at a minimum, the subject of the instant groups does not meet the standard of an "independent" invention, as required by M.P.E.P. §802.01, for a proper restriction requirement.

The second criterion, which must be met pursuant to M.P.E.P. §803, requires a serious burden on the Examiner for restriction to be required. In this instance, since the present claims are directed towards an apparatus for slabbing a roll, searching the art would necessarily involve the body of art classified under Class 83, Subclasses 488, and 489, and Classes 198 and 414. Applicants respectfully assert that the Examiner can, and in fact should, be able to search the present invention without serious burden. The instant

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group should not be restricted, much less restricted into four different sets of claims drawn to Applicants' claimed apparatus.

Having the Examiner perform the same search four or more times will lead to the same inevitable and ultimate conclusion: The claimed apparatus is novel and unobvious and thus so are the various embodiments claimed herein. Therefore, the novel and unobvious apparatus claimed will be, as a matter of law, novel and unobvious and will not require further restriction other than what will be performed under the instant Application.

Therefore, as required by the M.P.E.P., the instant groups are not independent inventions. Prosecuting the present invention without the Examiner's restriction does not impose a burden upon the Examiner. As such, neither of the two necessary criteria for the Examiner to establish the merited restriction requirement has been met. Thus, the restriction requirement, as presented, would be improper under current M.P.E.P. guidelines.

Respectfully submitted,

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